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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,320	08/16/2001	Paul Charles Downey	12000-901	3960

7590 09/04/2003

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EXAMINER

GLESSNER, BRIAN E

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/931,320

Applicant(s)

DOWNEY, PAUL CHARLES

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The following office action is in response to the amendment filed on July 21, 2003 and the RCE filed on August 19, 2003. Claims 1-28 are pending in the application. Claims 1-27 are rejected and claim 28 is withdrawn from consideration as being drawn to a non-elected invention.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 18, the scope of the claim is indefinite because the applicant is claiming that the substrate is fixed to the upper layer with an adhesive. This is indefinite because claim 13 only positively claims the substrate. Therefore, the examiner does not know if the applicant wants to claim the combination of the substrate and the upper layer, or the subcombination of merely the substrate. The examiner will examine the claim for the subcombination as "best understood" until further clarification is provided.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 8-11, 13-19, 21-23, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Kakimoto et al. (6,602,586).

In regard to claims 8 and 13, Kakimoto discloses a substrate for use in a flooring system that has a subfloor and a decorative upper layer, the substrate comprising a continuous sheet 2 having a bottom surface, a top surface, side surfaces and end surfaces, the top surface and the oppositely facing bottom surfaces are essentially parallel (column 5, lines 53-57, i.e. square or rectangular) to each other and are spaced apart by a thickness of the substrate, the thickness of the substrate being about 10mm (column 4, lines 2-4), voids are provided in the substrate, the voids are provided between particles of rubber (column 5, lines 20-24) such that when the substrate is positioned between the subfloor and the decorative top layer, the particles of rubber provide the strength required to prevent deformation of the substrate in the direction of the thickness and the voids contribute to the sound dampening characteristics required to provide decibel reduction across the thickness of the substrate (column 6, lines 42-53).

In regard to claims 9 and 15, Kakimoto discloses the claimed invention, wherein the density of the substrate 2 is less than 1000 kilograms per meter cubed (column 5, lines 25-27).

In regard to claims 10 and 16, Kakimoto discloses the claimed invention, wherein the substrate has the strength characteristics required to support the decorative top layer while having sufficient resiliency to allow the substrate to be delivered in rolls. Although Kakimoto does not specifically show or state the substrate could be rolled into rolls, he does disclose that the substrate has the same structural limitations as the applicant's substrate. Therefore, since the two substrates have the same structural limitations, they will inherently function in the same manner. Thus, it is inherent that Kakimoto's substrate could be rolled into rolls.

In regard to claims 11 and 19, Kakimoto discloses the claimed invention, wherein the substrate is made from an SBR rubber material (column 5, lines 32-33).

In regard to claim 14, Kakimoto discloses the claimed invention, wherein the continuous sheet is cut to the appropriate length to fit the space requirements.

In regard to claim 17, Kakimoto discloses the claimed invention, wherein the substrate is fixed to the subfloor by means of an adhesive (column 6, lines 6-16).

In regard to claim 18, as “best understood”, Kakimoto discloses the claimed invention, wherein said substrate is capable of being fixed to an upper layer by means of an adhesive.

In regard to claim 21, Kakimoto discloses a substrate for use in a flooring system that has a subfloor and a decorative upper layer, the substrate comprising all the limitations of the claim. Claim 21 contains the same limitations set forth in claims 8 and 9. Therefore, claim 21 is rejected on the same grounds of rejection set forth above with respect to claims 8 and 9.

In regard to claim 22, Kakimoto discloses the claimed invention, wherein the substrate has the strength characteristics required to support the decorative top layer while having sufficient resiliency to allow the substrate to be delivered in rolls. Although Kakimoto does not specifically show or state the substrate could be rolled into rolls, he does disclose that the substrate has the same structural limitations as the applicant’s substrate. Therefore, since the two substrates have the same structural limitations, they will inherently function in the same manner. Thus, it is inherent that Kakimoto’s substrate could be rolled into rolls.

In regard to claim 23, Kakimoto discloses the claimed invention, wherein the substrate is made from an SBR rubber material (column 5, lines 32-33).

In regard to claims 26 and 27, Kakimoto discloses the claimed invention, wherein the rubber sheet is a desired length. Kakimoto does not specifically disclose that said rubber is cut from a cylindrical member. However, this claim limitation is a process limitation. Therefore,

even though process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, since the final product is a rubber sheet, the claimed limitations are met because Kakimoto discloses the use of a rubber sheet.

***Claim Rejections - 35 USC § 103***

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ducharme (6,213,252) in view of Kakimoto et al. (6,602,586).

In regard to claim 1, Ducharme discloses a flooring system comprising a sub-floor 22, a “decorative” top layer 20, and a substrate 10 having a top surface and an oppositely facing bottom surface, the bottom surface positioned proximate the sub-floor and the top surface is positioned proximate the decorative top layer, the substrate having a thickness of about 10mm (i.e. between 1/64 of an inch and 3 inches, column 2, lines 12-14), the substrate is manufactured from rubber (column 3, lines 28-30) in sheets that are capable of being cut to the desired configuration, whereby it is obvious that the substrate has the strength characteristics to support the decorative layer and prevent damage thereto and the sound dampening characteristics to provide decibel reduction through the substrate (abstract i.e. sound absorbing substrate). Ducharme does not specifically disclose that said substrate has voids that extend between the top and bottom surface. Kakimoto teaches that it is known to provide a substrate 2 that is about 10mm thick that has voids (column 5, lines 20-24) that extend between a top surface and a bottom surface. It would have been obvious to one having ordinary skill in the art at the time the

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invention was made to incorporate Kakimoto's sheet into Ducharme's invention, because by using Kakimoto's sheet, one will not have to form grooves in the bottom of the sheet. Therefore, the manufacturing cost will be reduced, but the drainage characteristics of the sheet will be maintained.

In regard to claim 2, Ducharme in view of Kakimoto disclose the basic claimed invention, wherein the density of the substrate 2 is less than 1000 kilograms per meter cubed (column 5, lines 25-27).

In regard to claim 3, Ducharme in view of Kakimoto disclose the basic claimed invention, wherein the substrate has the strength characteristics required to support the decorative top layer while having sufficient resiliency to allow the substrate to be delivered in rolls. Although Kakimoto does not specifically show or state the substrate could be rolled into rolls, he does disclose that the substrate has the same structural limitations as the applicant's substrate. Therefore, since the two substrates have the same structural limitations, they will obviously be capable of functioning in the same manner. Thus, it is obvious that the substrate taught by Kakimoto could be rolled into rolls.

In regard to claim 4, Ducharme in view of Kakimoto disclose the basic claimed invention, wherein the substrate is fixed to the subfloor by means of an adhesive (column 4, lines 19-22).

In regard to claim 5, Ducharme in view of Kakimoto disclose the basic claimed invention, wherein the substrate is fixed to the decorative top layer (column 2, lines 61-62). Ducharme does not specifically disclose that the substrate is fixed to the top layer by means of an adhesive. It would have been obvious to one having ordinary skill in the art at the time the



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invention was made to use adhesive to fix the substrate to the top layer, because adhesive will securely fix the two layers together without causing any deformation to the top layer that nails or other mechanical fasteners would cause. Further, since adhesive is used between the substrate and subfloor, it would have been obvious to use the same fastening means between the substrate and the top layer for ease of assembly.

In regard to claim 6, Ducharme in view of Kakimoto disclose the basic claimed invention, wherein the substrate is made from SBR rubber material (column 5, lines 32-33, Kakimoto).

In regard to claim 7, Ducharme in view of Kakimoto disclose the basic claimed invention except for specifically disclosing that the sound dampening characteristics exhibit a decibel reduction of approximately 20 dB for a substrate with a thickness of 5 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the substrate taught by Kakimoto have a decibel reduction of 20 dB for a substrate of 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The examiner takes the position that since the applicant's substrate and the substrate taught by Kakimoto are the same, they will obviously be capable of performing the same functions.

4. Claims 12, 20, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakimoto et al. (6,602,586).

In regard to claims 12, 20 and 24, Kakimoto discloses the claimed invention except for specifically disclosing that the sound dampening characteristics exhibit a decibel reduction of approximately 20 dB for a substrate with a thickness of 5 mm. It would have been obvious to

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one having ordinary skill in the art at the time the invention was made to make Kakimoto's substrate have a decibel reduction of 20 dB for a substrate of 5 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The examiner takes the position that since the applicant's structure and Kakimoto's structure are the same, they will obviously be capable of performing the same functions.

In regard to claim 25, Kakimoto discloses the claimed invention except for specifically disclosing that said rubber is formed in a cylindrical member and the sheets are cut from the cylindrical member. However, this claim limitation is a process limitation. Therefore, even though process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Therefore, since the final product is a rubber sheet, the claimed limitations are met because Kakimoto discloses the use of a rubber sheet.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031.

The examiner can normally be reached on Monday-Friday 7:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.  
September 2, 2003

A handwritten signature in black ink, appearing to read "Brian E. Glessner", with a long horizontal flourish extending to the right.

**BRIAN E. GLESSNER**  
**PATENT EXAMINER**